

REMARKS

Claims 1-39 are all the claims pending in the application. Claims 1-39 have been examined and rejected under 35 U.S.C. § 103(a). The grounds of rejection are substantially the same as presented in the previous Office Action dated August 9, 2004. For at least the following reasons, Applicant respectfully traverses these rejections.

CLAIM REJECTIONS

A. 35 U.S.C. § 103(a) Rejection of Claims 1-3, 7-16, 20-29 and 33-39

Claims 1-3, 7-16, 20-29 and 33-39 have been rejected as being unpatentable over U.S. Patent No. 6,532,446 to King (“King”) in view of U.S. Patent No. 6,658,389 to Alpdemir (“Alpdemir”). Claims 4-6, 17-19 and 30-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over King in view of Alpdemir in further view of what the Examiner asserts is well known prior art. Applicant respectfully traverses this rejection.

Applicant reasserts the arguments set forth in the Amendment of November 9, 2004. The Examiner asserts in the Final Office Action that “obviousness is based on the prior art teachings and/or common knowledge in the art, because both references are in the same field of endeavor, including speech recognition/speech-to-text, providing speech processing services through network, and using voice communication channels and wireless devices.” (Office Action at p. 2-3). It is respectfully submitted that the Examiner’s asserted motivation to modify the teachings of King according to the teachings of Alpdemir is, however, improper.

That references are in the same broad field of endeavor is insufficient to provide motivation to combine references. Thousands, if not tens of thousands, of references exist in the speech recognition art. There is not, however, a motivation to combine any of these references

with any other of the references based solely on the references being in the same field of endeavor. The Examiner appears to take the position that the motivation to combine the teachings of the references is merely that these references can be combined. This alone, according to the Final Office Action, is ample motivation to make the combination. However that is not the law. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01, citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Here, the motivation the Examiner asserts is not directed to a motivation to combine or modify the cited references, but instead is merely an assertion of the ability to combine the references. Nothing cited by the Examiner suggests the desirability of the combination of cited art. For at least this reason, Applicant respectfully submits that *prima facia* case of obviousness has not been established.

Further, even assuming *arguendo* that a person of ordinary skill would have been motivated to combine the references as asserted in the Office Action, Applicant respectfully submits that the asserted combination of art fails to teach or suggest all the limitations of the claims. This is because the asserted combination would not include an apparatus having a computer program for “determining whether to filter the translated text[,] and if it is determined that the translated text is to be filtered, applying a filter to the translated text” as recited in claim 14. The Examiner asserts that this element is taught at col. 4, lines 25-35 and col. 10, lines 37-45 of King. However, neither the cited passages, nor any other teaching in the cited references, supports the Examiner’s assertion. King merely discloses in those passages that speech signals that have been processed into symbolic data files (col. 4, lines 25-35) can be formatted. (col. 10,

lines 33-48). King does not, however, disclose determining whether to filter translated text, as recited in, for example, claim 14. King does not disclose determining whether to apply a filter to translated text, since King merely describes formatting the symbolic file with no suggestion of filtering it. (*Id.*) It is respectfully submitted that Alpdemir fails to cure this deficiency. Accordingly, Applicant submits that claim 14 is patentable over the cited art for at least this additional reason. Applicant submits that independent claims 1 and 27 are patentable over the cited art for analogous reasons.

Since claims 2-3, 7-13, 15-16, 20-26, 28-29 and 33-39 depend from one of claims 1, 14 and 27, Applicant submits that these claims are patentable at least based on their respective dependencies.

B. 35 U.S.C. § 103(a) Rejection of Claims 4-6, 17-19 and 30-32

The Examiner asserts, without support, that the additional limitations recited in claims 4-6, 17-19 and 30-32 are well known in the art. However, as the Examiner's assertion of what is allegedly well known in the art fails to cure the deficiencies of King and Alpdemir as discussed above, and as each of claims 4-6, 17-19 and 30-32 depend on one of claims 1, 14 or 27, Applicant submits that claims 4-6, 17-19 and 30-32 are patentable over King in view of Alpdemir and in further view of what the Examiner asserts is well known in the art at least based on this dependency.

CONCLUSION

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Patent Appl'n No. 09/690,313

Atty Docket No. A8504

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

Date: July 19, 2005